

REMARKS

Claims 1, 4 through 11 and 14 through 16 are pending in this application. Claim 1 has been amended by incorporating the limitations of claims 2 and 3 therein, and claims 2 and 3 cancelled. Claim 11 has been amended by incorporating the limitations of claims 12 and 13 therein, and claims 12 and 13 cancelled. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1 Through 5 And 7 Through 16 Were Rejected Under 35 U.S.C. §103 For Obviousness Predicated Upon Hiroshi et al.

Applicants initially note that since the limitations of claims 2 and 3 have been incorporated into claim 1, and the limitations of claims 12 and 13 have been incorporated into claim 11, the Examiner's rejections of claims 2, 3, 12 and 13 will be addressed, thereby addressing independent claims 1 and 11.

In rejecting claims 2, 3, 12 and 13 the Examiner admitted that Hiroshi et al. do not disclose a filler with the recited average particle size and maximum particle size, and further admitted that Hiroshi et al. do not disclose a surface roughness of the chamfer as claimed. Rather than complying with judicial precedent by providing facts and fact-based reasoning, the Examiner simply concluded that such recited claim limitations are "... considered to be obvious . . ." (second full paragraph on page 4 of the March 23, 2005 Office Action and paragraph bridging pages 4 and 5 thereon). This rejection is traversed as factually and legally erroneous.

There Is No Prima Facie Case.

In order to establish the requisite realistic motivation the Examiner must make clear and particular factual findings as to a specific understanding or specific technological principle and then, based upon such factual findings, explain **why** one having ordinary skill in the art would have been realistically motivated to modify particular prior art, in this case, the particular ferrule disclosed by Hiroshi et al., to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *Ecolochem Inc. v. Southern California Edison, Co.* 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The Examiner did not even attempt to discharge that burden. Rather, the Examiner espouses unsupported generalizations about the dependence of protection on the particle size, and the dependence of fiber inserting and holding on surface roughness, and then concluded that the claimed invention would have been obvious. This approach is clearly legally erroneous.

The Examiner simply failed to provide the requisite factual basis and fact-based reasoning to support the asserted motivation. *In re Lee, supra*. Moreover, the Examiner did not even provide a factual basis upon which to predicate the determination that the recited parameters, i.e., average particle size, maximum particle size, and surface roughness, are art-recognized result effective variables. Absent any such objective evidence, it is legally erroneous to conclude that one having ordinary skill in the art would somehow have been realistically lured to manipulate such variables. See *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re Yates*, 663 F.2d 1054, 211 USPQ 1149 (CCPA 1981); *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

Based upon the foregoing it is apparent that the Examiner failed to establish a prima facie basis to deny patentability to the claimed invention for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, there is objective evidence of **nonobviousness** of record.

Objective Evidence Of Nonobviousness

It is well settled that all evidence relevant to the ultimate legal conclusion of **nonobviousness** must be given consideration. *Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). It is also well settled the Examiner cannot ignore objective evidence in the specification. *In re Soni*, 54 F.3d 746, 34 USPQ2d 1685 (Fed. Cir. 1995); *In re Margolis*, 785 F.2d 1029, 228 USPQ 940 (Fed. Cir. 1986).

Adverting to Fig. 10 of the present application and to the related discussion thereof in the first full paragraph on page 19 of the written description of the specification, one having ordinary skill in the art would have recognized that when the average particle size of the filler is no more than 20 μm , the occurrence ratio of loss increment of no less than 0.3 dD is zero. It follows that one having ordinary skill in the art would have recognized the significance of the maximum recited particle size of the filler.

Further, adverting to Fig. 11 and the related discussion thereof in the second full paragraph on page 19 of the written description of the specification, one having ordinary skill in the art would have recognized that the recited surface roughness of the chamfer is significant with respect to the initial loss (being close to 0.15db) as well as stability.

The Examiner committed clear legal error by ignoring such evidence in the specification. Manifestly, the Examiner did not offer any technological reason inconsistent with such evidence. Accordingly, the evidence in the specification must be accepted and considered. *In re Clinton*, 527 F.2d 1226, 188 USPQ 365 (CCPA 1976).

Conclusion

Based upon the foregoing it should be apparent that a *prima facie* basis to deny patentability to the claimed invention has not been established for lack of the requisite factual basis and want of the realistic motivation. Moreover, upon giving due consideration to the objective evidence of **nonobviousness** in this application, the conclusion appears inescapable that one having ordinary skill in the art would **not** have found the claimed invention **as a whole** obvious within the meaning of 35 U.S.C. §103. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

Applicants, therefore, submit that the imposed rejection of claims 1 through 5 and 7 through 16 under 35 U.S.C. §103 for obviousness predicated upon Hiroshi et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claim 6 was rejected under 35 U.S.C. §103 for obviousness predicated upon Hiroshi et al. in view of Stein.

This rejection is traversed. Specifically, claim 6 depends from independent claim 1. applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. §103 for obviousness predicated upon Hiroshi et al.

The secondary reference to Stein does not cure the previously argued deficiencies of Hiroshi et al.

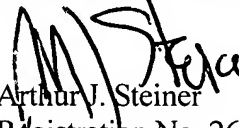
Applicants, therefore, submit that the imposed rejection of claim 6 under 35 U.S.C. §103 for obviousness predicated upon Hiroshi et al. in view of Stein is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should appear that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



Arthur J. Steiner
Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 AJS/lrd/ntb
Facsimile: (202) 756-8087
Date: June 14, 2005